

## REMARKS

This is a reply to the Office Action mailed November 4, 2003, with a shortened statutory response period of three (3) months from the mailing date, extended two months by Petition filed herewith. The Commissioner is hereby authorized to charge any additional fees to Deposit Account number 02-1818.

Claims 98-126 have been canceled by this amendment. Claims 1-97 are presently pending in the application. Applicants have amended the specification to properly include "glyceryl esters" in the group of nonionic surfactants instead of in the group of anionic surfactants, and have also amended claims 3-4, 18-19, 27-28, 32-33, 44-45, and 54-55 to reflect said amendment. Claims 60 and 61 have been amended to include "or x-ray diffraction". Support for this amendment can be found in the specification at page 8, line 10; at page 15, line 29; at page 16, lines 2-3; and throughout the examples cited in the specification. Thus, no new matter has been added.

### I. Double Patenting Rejections

Claims 1-97 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-120 of co-pending Application No. 09/953,979. Applicants traverse this rejection but submit that these rejections can be more effectively addressed upon receiving a Notice of Allowance for claims in this or the other application that forms the basis of this rejection.

### II. Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1-5, 7-20, 22-29, 31-34, 36-46, 48-56, 58, 59, and 66-97 under 35 USC 103(a) in view of *Stainmesse*. Applicants respectfully traverse this rejection.

*Stainmesse* does not recite adding energy through heating, sonication, homogenization, counter-current flow homogenization or microfluidization as is required in claims 1-59 and 66-97 as presently amended. *Stainmesse* discloses using stirring with a stirring bar but teaches away from the recited energy adding techniques. To this end *Stainmesse* discloses as follows:

"...and the use of sophisticated equipment with high energy requirements (sonicators, homogenizers...) constitute serious handicaps to their industrial application." (Col. 1, 57-59).

“Since this emulsion must be very fine, the use of surfactants and the necessary equipment (sonicator, etc.) is essential for the production of nanoparticles of appropriate size.” (Col. 2, lines 4-6)

*Stainmesse* specifies that it is an advantage of its method not to require the supply of energy:

“The process for the preparation of nanoparticles according to the invention offers the following advantages compared with known processes: the production of nanoparticles smaller than 500 nm and in particular of about 200 nm by means of a simple method not requiring the supply of energy.” (Col., 4, lines 61-66)

Accordingly, *Stainmesse* discourages utilizing the claimed process requiring the supply of energy like sonication and homogenization.. Therefore, *Stainmesse* teaches away from claims 1-59 and 66-97.

Further, *Stainmesse* teaches away from the methods recited in claims 60-65. Claim 60 recites a method for making submicron sized particles including the step of annealing a pre-suspension. The term “annealing” is defined as “...the process of converting matter that is thermodynamically unstable into a more stable form by single or repeated application of energy (direct heat or mechanical stress), followed by thermal relaxation.” (specification, pg. 7, lines 3-5.) *Stainmesse* discloses, as set forth above, that is process does not require the addition of energy, and, therefore, teaches away from an annealing step.

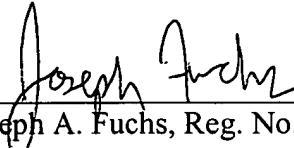
The Examiner has rejected claims 60-65 and 98-128 under 35 U.S.C. §103 in view of the combination of *Stainmesse* and *Hanna*. Claims 98-128 have been canceled by this amendment rendering these rejections moot. As for claims 60-65, because *Stainmesse* teaches away from annealing particles, it cannot be properly combined with *Hanna*.

Accordingly, Applicants respectfully submit the pending claims are non-obvious, and patentable in view of *Stainmesse* or *Stainmesse* combined with *Hanna*.

In view of the foregoing Amendments and Remarks, Applicants respectfully submit that Claims 1-97 are in condition for allowance and respectfully request early notice of the same.

Respectfully submitted,  
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